

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN NEWMAN and ROBERT A. PRAECHTER

Appeal No. 1998-0408
Application No. 08/176,861

ON BRIEF

Before COHEN, McQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-12 and 20-28, which are all of the claims pending in this application. Claim 1 was amended in an amendment filed January 29, 1996 (Paper No. 10), with the brief (Paper No. 9).

BACKGROUND

The appellants' invention relates to a wristband (claims 1-12 and 23-27) and a method of facilitating payment for goods

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or services at an amusement park (claims 20-22 and 28). An understanding of the invention can be derived from a reading of exemplary claims 1 and 20, which appear in the appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. § 103 are:

| | | |
|---------------------------------------|-----------|---------------|
| Twentier | 3,153,869 | Oct. 27, 1964 |
| Hansen, Sr. (Hansen) | 4,879,162 | Nov. 7, 1989 |
| Melin et al. (Melin) | 5,279,057 | Jan. 18, 1994 |
| Ohno (European patent application) | 552,656 | Jul. 28, 1993 |

The following rejections are before us for review.

(1) Claims 1-12 and 20-28¹ stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

(2) Claims 1-4, 12, 20-22 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melin in view of Hansen.

¹ The rejection of claims 23-28 under 35 U.S.C. § 112 was added as a new ground of rejection in the examiner's answer.

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(3) Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Melin in view of Hansen and Ohno.

(4) Claims 10, 11, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melin in view of Hansen and Twentier.

Reference is made to the brief, first reply brief and second reply brief (Paper Nos. 9, 12 and 18) and the answer and supplemental answer² (Paper Nos. 11 and 17) for the respective positions of appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

² The paper entitled "EXAMINER'S ANSWER" mailed August 17, 1999, is in fact, a supplemental answer.

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The purpose of the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). Accordingly, the legal standard for definiteness under the second paragraph of 35 U.S.C. § 112 is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 1-12 and 23-27

With regard to claims 1-12 and 23-27, the examiner's position, as stated on page 3 of the answer, is as follows:

In claim 1, the phrase "an elongated strip...which is tear resistance [sic: resistant] but will tear completely if subjected to a force which would jeopardize the safety of the wearer in an amusement park environment" is indefinite because the applicant does not claim nor disclose the magnitude of the "force which would jeopardize the safety of the wearer in an amusement park." Specifically, the applicant does not claim or disclose structure to support the above functional language. The applicant does not disclose the

specific material in which the wristband is made, the minimum force required to tear the wristband completely, or the force which would jeopardize the wearer of the wristband. In addition, since the force required to tear the wristband completely without jeopardizing the safety of a wearer may vary for person to person depending on the size, age, and/or physical condition of the wearer, the positive recitation of the force which would jeopardize the safety of the wearer in an amusement park is indefinite.

In response, appellants argue on page 5 of the brief that

[i]t is not the magnitude of the force which is significant, it is that the wristband be engineered so that whatever the magnitude of the force turns out to be (and safety standards may change from year to year, and from children to adults) that the wristbands tear completely if subjected to such a force.

Claim 1 recites a strip of a first material "which is tear resistant but will tear completely if subjected to a force which would jeopardize the safety of the wearer in an amusement park environment if it did not tear." We understand this limitation to mean that the wristband strip will tear completely if subjected to any force which would jeopardize the safety of the wearer if it did not tear. An issue before us in this appeal is whether appellants' claims, when read in light of the underlying disclosure, apprise one of ordinary skill in the art what degree of tear resistance (i.e., the

force required to tear the strip) is necessary to fall within the scope of the claimed subject matter. The only guidance provided by appellants' specification³, aside from a statement which merely reiterates the claim language itself (page 2), is a disclosure that "[o]ne ideal material for the strip 11 is eight point KIMDURA waterproof paper available from Kimberly Clark" (page 7, lines 8-10)⁴. We cannot glean from appellants' specification any fair understanding of the forces in the intended environment which would be deemed to "jeopardize the safety of the wearer" if the strip did not tear or, indeed, a standard for determining what constitutes jeopardy of safety so as to enable one of ordinary skill in the art to ascertain the metes and bounds of the claimed invention.⁵ Moreover, appellants have not argued, let alone

³ When words of degree are used in a claim, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

⁴ In this regard, the examiner's statement, quoted supra, that appellants do not disclose the specific material from which the wristband is made is inaccurate.

⁵ From our point of view, appellants' reliance (brief, page 6) on In re Caldwell, 319 F.2d 254, 138 USPQ 243 (CCPA 1963) (at issue was a limitation involving an effective amount of aspirin to promote growth) and In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("essentially free of alkali

(continued...)

shown by evidence, that there are any established standards known to those of ordinary skill in the field of appellants' invention for determining the acceptable range of tear resistance to achieve the recited function. In this regard, appellants' brief (page 5) refers to "safety standards [which] may change from year to year, and from children to adults," but does not point to any such established safety standards. While appellants' specification discloses one example of an ideal paper (eight point KIMDURA waterproof paper) for use in the invention and while the tear resistance of that paper is presumably known in the art, the reference to one example which falls within the scope of the invention is not sufficient, alone, to establish the full range of tear resistance covered by the claims.

For the foregoing reasons, it is not apparent to us how one of ordinary skill in the art would be able to determine

⁵(...continued)
metal" limitation not indefinite) is misplaced, in that those cases involved functional limitations which were not per se critical to the invention and were of such a nature that one of ordinary skill in the art would readily be able to ascertain whether or not a particular structure or process met those limitations. In contrast, appellants' specification (page 2, lines 9-12 and 25-27) and arguments (brief, page 8) illustrate that the degree of tear resistance is a critical feature of appellants' invention.

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whether a particular strip of material, other than eight point KIMDURA paper, would be covered by independent claim 1 or claims 2-12 and 23-27 which depend therefrom. For example, as discussed infra, it is impossible to determine with any certainty whether the tear resistant glass fibre-reinforced paper of Melin, while not disclosed as having a safety release feature, inherently possesses the degree of tear resistance required by these claims. We therefore conclude that claims 1-12 and 23-27 fail to reasonably apprise one of ordinary skill in appellants' field of invention of their scope and thus do not meet the definiteness requirement of the second paragraph of 35 U.S.C. § 112.

Accordingly, we shall sustain the examiner's rejection of claims 1-12 and 23-27 under the second paragraph of 35 U.S.C. § 112.

Claims 20-22 and 28

The examiner's bases for rejecting claims 20-22 and 28 under the second paragraph of 35 U.S.C. § 112 are that (1) appellants do not claim structure to support scanning the bar code and (2) it is unclear how the bar codes are related to a particular amount of goods and services (answer, page 3).

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As to the first basis, we perceive no requirement in the second paragraph of 35 U.S.C. § 112 that a method claim explicitly recite the structure used to perform the recited method steps. From our perspective, to the extent that a particular known structure (e.g., a bar code reader) is inherently required to perform the scanning step, recitation of the scanning step implicitly includes the use of such structure.

With regard to the second basis, it is not clear to us exactly what the examiner considers to be lacking in the claim and the examiner has not further elaborated in this regard. In light of the underlying disclosure and the preambular language of claim 20 directed to a "method of facilitating payment for goods or services," we understand the "relating" step to be a step of associating with the bar coding on the wristband a dollar or other credit amount which can be applied for the payment of goods or services purchased by the wearer. While the particular claim language selected by appellants may be less precise than desired, in that it refers to a particular amount of goods or services rather than a particular amount (of money or other credit) for goods or

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services, it is our opinion that one of ordinary skill in the art reading the specification and claims as a whole would understand what is meant by this claim language.

In light of the foregoing, we shall not sustain the examiner's rejection of claims 20-22 and 28 under 35 U.S.C. § 112, second paragraph.

The obviousness rejections

Claims 1-4, 10-12, 26 and 27

Turning first to the examiner's respective rejections of claims 1-4, 10-12, 26 and 27 under 35 U.S.C. § 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated supra, no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations

and assumptions are necessary in order to determine what in fact is being claimed. In particular, we note that the glass fibre-reinforced paper strip of Melin is "tear-resistant"; however, in that appellants' specification does not provide sufficient guidance determining the degree of tear resistance required to meet the functional (safety) limitation of claim 1, we are unable to ascertain with any certainty whether Melin's strip inherently possesses the necessary tear resistance. Since a rejection based on prior art cannot be based on speculations and assumptions (see In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962)), we are constrained to reverse, pro forma, the examiner's rejections of claims 1-4, 10-12, 26 and 27 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the 35 U.S.C. § 103 rejections.

Claims 20-22 and 28

The examiner's rationale in rejecting claims 20-22 and 28 under 35 U.S.C. § 103 as being unpatentable over Melin in view of Hansen is that,

since Melin and Hansen teaches a waterproof and tear resistance [sic: resistant] wrist band having a bar

code disposed thereon for use in a fair and since the relating [of] bar codes to information such as goods and services utilizing instruments such as bar code reader[s] and computer[s] is old and well known in the art, the method limitation[s] are inherent [answer, page 6].

Melin discloses a water resistant paper strip having a bar code thereon (column 1, line 61) and, further, appears to suggest use of such a strip as a limb band for identification of persons (column 1, lines 24-29⁶). Additionally, we accept the examiner's assertion that relating bar codes to information such as goods and services was known in the art at the time of appellants' invention. However, we find no teaching or suggestion in either Melin or Hansen of using a wristband having bar coding in a method of facilitating payment for goods or services at an amusement park, including a step of relating the bar coding of the wristband to a particular amount of [for] goods or services that a human patron wearer of the wristband is entitled to purchase, as required by claim 20, and the examiner has offered no

⁶ U.S. Pat. No. 2,561,894, issued to F. R. Wallich on July 24, 1951 and referenced in Melin, provides such disclosure. We also note of interest the disclosure in the Wallich patent of a varnish applied over the legend or name inscribed on the band (column 2, lines 21-28), which appears pertinent to the subject matter of claims 1-12 and 23-27.

explanation as to why such a method would inherently result from following the teachings of the applied references.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

For the reasons discussed above, it appears to us that the examiner's obviousness rejection of claims 20-22 and 28 stems from such speculation, unfounded assumptions or hindsight reconstruction. Accordingly, we cannot sustain the examiner's 35 U.S.C. § 103 rejection of these claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12 and 20-28 under 35 U.S.C. § 112, second paragraph, is affirmed as to claims 1-12 and 23-27 and reversed as to claims 20-22 and 28. The examiner's decision to reject claims 1-4, 10-12, 20-22 and 26-28 under 35 U.S.C. § 103 is reversed.

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Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
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